



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Kazunari KURITA et al.

Art Unit: 1791

Application No.: 10/576,321

Examiner: Chaet, M.

Filed: 04/19/2006

Attorney Dkt. No.: 12054-0059

For: PROCESS FOR PRODUCING HIGH-RESISTANCE SILICON WAFERS AND
PROCESS FOR PRODUCING EPITAXIAL WAFERS AND SOI WAFERS (AS
AMENDED)

**SUBMISSION OF TERMINAL DISCLAIMERS AND REQUEST FOR
RECONSIDERATION**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This filing is in response to the final Office Action dated December 18, 2007.

First, Applicants are submitting herewith Terminal Disclaimers to address the two obviousness-type double patenting rejections. It should be noted that serial number 10/519,837 has matured into United States Patent No. 7,316,745 and it is this patent that is used in one of the Terminal Disclaimers. With the filing of these Terminal Disclaimers and their fees, these rejections are overcome.

Second, Applicants traverse the rejection based on 35 U.S.C. § 103(a) and the combination of Falster and Sadamitsu. The reason for this traversal is that Sadamitsu is not prior art against the application and the Examiner can only rely on Falster to make the rejection. However, since the reasoning for the rejection clearly requires the teachings of Sadamitsu but they are not available to use to formulate the rejection, the rejection based on 35 U.S.C. § 103(a) and only Falster is

insufficient to establish a *prima facie* case of obviousness.

In the rejection, the Examiner argues that the effective filing date of Sadamitsu is June 30, 2003, which precedes Applicants' effective filing date of October 21, 2003. The assertion that Sadamitsu's effective filing date is June 30, 2003 is incorrect. The June 30, 2003 filing date of Sadamitsu is the PCT or international filing date. This is only an effective filing date if the PCT application was published in English, see 35 U.S.C. § 102(e), and Sadamitsu's PCT application was published in Japanese. The date for prior art purposes for Sadamitsu is the publication of the PCT application in January of 2004, which is after the October 21, 2003 effective filing date of the instant application. Therefore, the rejection is improper and must be withdrawn.

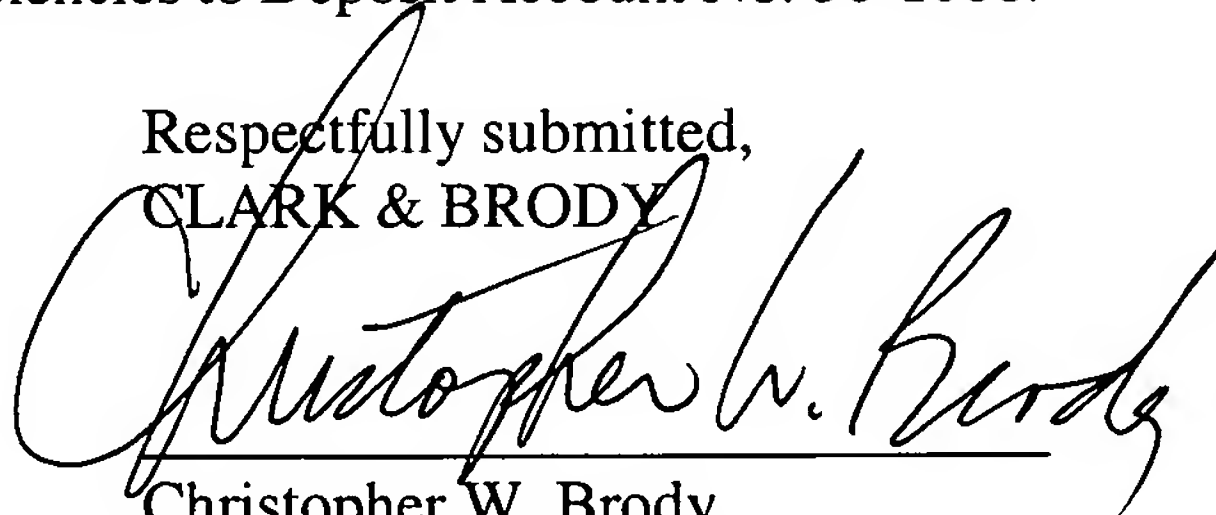
In light of the argument made above and submission of the Terminal Disclaimers, this application is in immediate condition for allowance and all claims should be passed onto issuance.

If the Examiner believes that an interview would be helpful in expediting the allowance of this application, the Examiner is requested to telephone the undersigned at 202-835-1753.

Again, reconsideration and allowance of this application is respectfully requested.

A check in the amount of \$260.00 is enclosed to cover the cost of the two Terminal Disclaimers. Please charge any fee deficiencies to Deposit Account No. 50-1088.

Respectfully submitted,
CLARK & BRODY



Christopher W. Brody
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Docket No.: 12054-0059
Date: February 21, 2008

**TERMINAL DISCLAIMER TO OBVIATE A DOUBLE PATENTING
REJECTION OVER A "PRIOR" PATENT**Docket Number (Optional)
12054-0059

In re Application of: Kanunari Kurita

Application No.: 10/576,321

Filed: 04/19/2006

For: Process for Producing High-Resistance Silicon Wafers and Process for Producing Epitaxial Wafers and SOI Wafers (as amended)

The owner*, Sumitomo Mitsubishi Silicon Corporation, of 100 percent interest in the instant application hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application which would extend beyond the expiration date of the full statutory term **prior patent** No. 7,316,745 as the term of said prior patent is defined in 35 U.S.C. 154 and 173, and as the term of said **prior patent** is presently shortened by any terminal disclaimer. The owner hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and the **prior patent** are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.

In making the above disclaimer, the owner does not disclaim the terminal part of the term of any patent granted on the instant application that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. 154 and 173 of the **prior patent**, "as the term of said **prior patent** is presently shortened by any terminal disclaimer," in the event that said **prior patent** later:

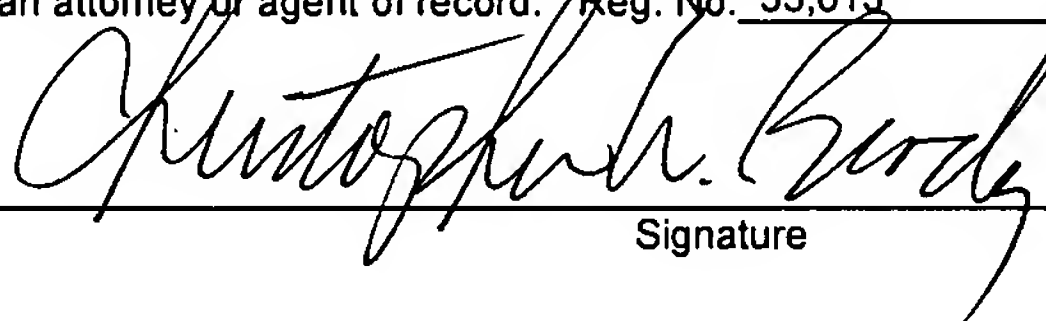
- expires for failure to pay a maintenance fee;
- is held unenforceable;
- is found invalid by a court of competent jurisdiction;
- is statutorily disclaimed in whole or terminally disclaimed under 37 CFR 1.321;
- has all claims canceled by a reexamination certificate;
- is reissued; or
- is in any manner terminated prior to the expiration of its full statutory term as presently shortened by any terminal disclaimer.

Check either box 1 or 2 below, if appropriate.

1. ☐ For submissions on behalf of a business/organization (e.g., corporation, partnership, university, government agency, etc.), the undersigned is empowered to act on behalf of the business/organization.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

2. ☒ The undersigned is an attorney or agent of record. Reg. No. 33,613



Signature

02/21/2008

Date

Christopher W. Brody

Typed or printed name

202-835-1753

Telephone Number

- ☒ Terminal disclaimer fee under 37 CFR 1.20(d) included.

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

*Statement under 37 CFR 3.73(b) is required if terminal disclaimer is signed by the assignee (owner).
Form PTO/SB/96 may be used for making this certification. See MPEP § 324.

This collection of information is required by 37 CFR 1.321. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

**TERMINAL DISCLAIMER TO OBVIATE A PROVISIONAL DOUBLE PATENTING
REJECTION OVER A PENDING "REFERENCE" APPLICATION**

Docket Number (Optional)

12054-0059

In re Application of: Kazunari Kurita

Application No.: 10/576,321

Filed: 04/19/2006

For: Process for Producing High-Resistance Silicon Wafers and Process for Producing Epitaxial Wafers and SOI Wafers (as amended)

The owner*, Sumitomo Mitsubishi Silicon Corporation, of 100 percent interest in the instant application hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application which would extend beyond the expiration date of the full statutory term of any patent granted on pending **reference** Application Number 10/512,405, filed on 06/15/2005, as such term is defined in 35 U.S.C. 154 and 173, and as the term of any patent granted on said **reference** application may be shortened by any terminal disclaimer filed prior to the grant of any patent on the pending **reference** application. The owner hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and any patent granted on the **reference** application are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.

In making the above disclaimer, the owner does not disclaim the terminal part of any patent granted on the instant application that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. 154 and 173 of any patent granted on said **reference** application, "as the term of any patent granted on said **reference** application may be shortened by any terminal disclaimer filed prior to the grant of any patent on the pending **reference** application," in the event that: any such patent: granted on the pending **reference** application: expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 CFR 1.321, has all claims canceled by a reexamination certificate, is reissued, or is in any manner terminated prior to the expiration of its full statutory term as shortened by any terminal disclaimer filed prior to its grant.

Check either box 1 or 2 below, if appropriate.

1. ☐ For submissions on behalf of a business/organization (e.g., corporation, partnership, university, government agency, etc.), the undersigned is empowered to act on behalf of the business/organization.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

2. ☒ The undersigned is an attorney or agent of record. Reg. No. 33,613

Signature

02/21/2008

Date

Christopher W. Brody

Typed or printed name

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